

REMARKS

The Official Action of July 3, 2003, and the prior art cited and applied therein have been carefully reviewed. The claims in the application are now claims 1-13 and 19-21, and these claims are believed to define patentable subject matter consistent with what is stated in the Official Action, whereby these claims should be in condition for formal allowance. Accordingly, applicant respectfully requests favorable consideration and early formal allowance.

Acknowledgement by the PTO of the receipt of applicants' papers filed under Section 119 is noted.

The Office Action indicates that applicant's specification attempts to incorporate essential material by reference to a foreign application or a foreign patent or publication. With respect, applicant disagrees. No attempt whatsoever is made to incorporate essential material by reference.

The publications in question simply refer to the state of the art, information known or charged to those skilled in the art. There is no need for applicant to attempt to incorporate such material by reference because those skilled in the art are presumed to know what exists in the art

prior to the date of the invention, and applicant's specification is simply pointing out where this known material may be found¹.

For example, attention is respectfully invited to *ex parte Porter*, 25 USPQ 2d 1144,1146 (BPAI 1992), where the Board stated:

..., the specification discusses the prior art... that addresses the problem of removal of catalyst from reactor tubes. Against this background of the exemplary knowledge of one of ordinary skill in the art, we have no difficulty in finding that one of ordinary skill in the art would know how to insert the nozzle of the instant invention into a sealed head and how to maintain a pressure differential....

Also see *Paperless Accounting v. Bay Area Rapid Transit System*, 231 USPQ 649, 653 (1986), where the Court stated:

A patent applicant need not include in the specification that which is already known to be available to the public [citations omitted].

Lastly, attention is respectfully invited to the decision of the Supreme Court of The United States in *Loom Co. v. Higgins*, 105 U.S. 580, 586 (1881), where it is stated that the applicant

may begin at the point where his invention begins, and describe what he has made that is new, and what it replaces of the old. That which is common and well known is as if

¹ WO '272 and WO '078 correspond respectively to the cited U.S. patents 6,015,501 and 6,458,282.

it were written out in the patent and delineated in the drawings.

Indeed, any other way would be impossible, as then every patent applicant would need to present an immensely prolix specification.

Withdrawal of the requirement is respectfully requested.

Claims 4 and 8-13 have been objected to as being in improper multiply dependent form. Appropriate amendments have now been made above to place these claims in proper form for U.S. practice. These amendments are clearly not "narrowing" amendments, but are made only for formal purposes.

Claims 1-3, 5-7 and 14-18 have been rejected under the second paragraph of §112. This rejection is respectfully traversed.

Claims 14-18 have been deleted without prejudice to the present invention, applicant relying on his rights (including those under §§ 120 and 119) to pursue the subject matter of such claims (if applicant chooses to do so) in a continuing application, without any penalty whatsoever.

The rejection states correctly that clauses starting with the words "particularly" and "especially" are in general not consistent with U.S. practice. The word "particularly"

appears only in original claims 1 and 18, and the word "especially" appears only in original claim 18. As pointed out above, claim 18 has been deleted from the present application.

With respect to claim 1, the word "particularly" was present only in the claim preamble, which in any event is usually not given any weight, but is merely considered in the PTO to be part of a statement of intended use. If the preamble is not given any weight, then the words which are present in the preamble cannot make the claim indefinite. Accordingly, claim 1 in its original form is fully in accordance with §112; at **worst**, it might be considered objectionable in its original form, but **only** as to form.

Nevertheless, in deference to the Examiner's views and to minimize needless argument, the clause starting with the word "particularly" has now been deleted from the preamble of claim 1. Such amendment is of a formal nature only, i.e. made to place the claims in better form consistent with U.S. practice or the Examiner's understanding thereof. Such an amendment is certainly not a "narrowing" amendment because the scope of the claims has not been reduced in this regard, and indeed might even be considered to be enlarged.

The rejection contains another criticism of claim 1 which is unclear to applicant. In this regard, the rejection

states that the pre-characterizing part of claim 1 recites that "the separation compartment (D) is in open communication with the upper subcompartment (B) of the collection compartment (A)". Looking at Fig. 1, it is seen that water with entrained lighter particles (e.g. oil particles) flows as indicated by the arrows from the upper subcompartment (B) of the collection compartment (A) through the annular passage formed between the flange 13A and the bottom wall plate 17 into the separation compartment (C).

The characterizing part of claim 1 calls for a valve (formed by the annular plate 16 and the cooperating seat 13B) "which is provided at the top of the separation compartment (D) and when in an open position connects the separation compartment (D) with the upper subcompartment (B) of the collection compartment (A)". In other words, the characterizing part calls for a part which when in an open position as shown in Fig. 2 provides a second communication or flow path between the separation compartment D and the subcompartment B so that the oil separated and accumulated in the separation compartment can flow into the subcompartment B and expelled therefrom.

Thus, the valve has nothing to do with the communication mentioned in the precharacterizing part. When the rejection states, in the second clause of the second

sentence, with reference to the precharacterizing part, that claim 1 "then recited a valve for providing such communication", it therefore seems that the PTO has misinterpreted claim 1, because the PTO apparently and mistakenly believes that it is the valve in the characterizing part that provides that communication mentioned in the precharacterizing part.

Claim 1 is believed to be absolutely clear, and correct, no further amendments are needed.

As regards the use of figure reference numbers in the claims, applicant agrees fully with the Examiner. Such reference characters are not needed, and are present only as an aid. Indeed, the reference characters are not to be utilized as any limitation on the claimed subject matter, noting MPEP 608.01(m). Applicant authorizes the Examiner, upon allowance, to delete the reference numerals by Examiner's Amendment or by so-called "red-inking", if the Examiner believes it would be desirable or preferable to do so.

Applicant respectfully requests withdrawal of the rejection.

Claims 14-18 have been rejected on the basis of prior art, but these claims have been deleted and thus these

prior art rejections need not be addressed at the present time.

Claims 1-3 and 5-7 have been indicated as being directed to "allowable" subject matter. These claims have not been rejected on the basis of any prior art. Applicant accordingly understands that these claims are deemed by the PTO to define novel and unobvious subject matter under §§ 102 and 103.

All the presently pending claims are now in good form and depend either directly or indirectly from patentable claim 1, except for new claims 20 and 21, and accordingly all such claims which depend directly or indirectly from claim 1 should now be in condition for formal allowance.

New claim 20 is a second independent claim which corresponds closely with allowable claim 1, and the dependent portion of new claim 21 corresponds with the dependent portion of claim 4. These claims should therefore be patentable for the same reasons as claims 1 and 4.

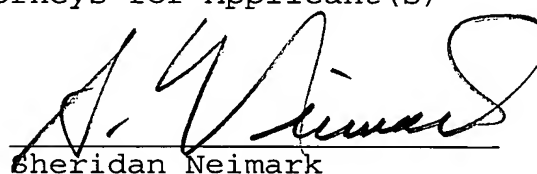
The prior art documents of record and not relied upon have been noted along with the implication that such documents are deemed by the PTO to be insufficiently pertinent to warrant their applications against any of applicant's claims.

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Applicant believes that all issues have been addressed and resolved, whereby the present application should be in condition for formal allowance. Such is respectfully requested.

Respectfully submitted,
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By

A handwritten signature in black ink, appearing to read "S. Neimark", is written over a horizontal line.

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